

REMARKS

Applicants have amended claims 1, 5, 12, 18-20, and 22-25, and have cancelled claims 26-28. As amended, Claim 1 recites a method for producing a transgenic mouse which overexpresses a polypeptide having PDGF-C activity in a heart-specific manner and develops heart hypertrophy or fibrosis. The claim amendments are fully supported by the specification as originally filed. For example, support for amendment to Claim 1 can be found at e.g. the paragraph bridging pages 16 and 17, and canceled claim 28. Entry and favorable reconsideration are respectfully requested.

Claim Objections

The Office Action objected to Claims 15, 20, and 22-28 for the use of the definite article "the" in the preamble. Claims 26 and 28 have been cancelled. With regard to the other claims, applicants respectfully submit that the objection is improper. In fact, changing "a" to "the" in each case would render the recitation to lack antecedent basis. Reconsideration and withdrawal of this objection are respectfully requested.

Applicants submit that the recitation of "an amino acid sequence" in Claims 18, 19 and 25 is proper. In order to expedite prosecution, however, applicants have changed these recitations to "the amino acid sequence," rendering the objection moot. Similarly, applicants respectfully submit that the objections to Claims 23 and 24 have been overcome by their amendments.

Claim Rejections under 35 U.S.C. § 112, ¶ 2

The Office Action rejected Claims 1, 5-9, 12, 14, 15, 20, 22-28 for indefiniteness, asserting that the recitation in Claim 1 of "develops hypertrophy..." in the preamble "does not give weight to the phenotype." While applicants respectfully disagree, the relevant claims (apart from Claims 26-28 which have been cancelled) have been amended, overcoming this rejection.

Applicants further respectfully submit that amendments to Claims 20 and 22-24 have overcome their respective rejection under 35 U.S.C. § 112, ¶ 2.

Claim Rejections under 35 U.S.C. § 102 and § 103

The Office Action rejected all pending claims under 35 U.S.C. § 102(e) over Gao et al. (U.S. Pat. # 6, 432,673), or under 35 U.S.C. § 103 over Gat et al. in view of Prusiner et al. (U.S. Patent # 5, 789,655). Applicants respectfully traverse these rejections with regard to Claims 26-28, which recited that the PDGF-D construct is under the control of a heart-specific promoter, specifically an alpha-myosin heavy chain promoter, and the resultant transgenic mouse develops heart hypertrophy or fibrosis. Gao et al. does not teach or suggest such heart-specific expression or phenotype. It is axiomatic that for a reference to anticipate, each and every element of the claimed invention must be disclosed in the references. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Accordingly, Applicants respectfully submit that all rejections of claims 26-28 under 35 U.S.C. § 102 are improper and should be withdrawn.

The secondary reference, Prusiner et al., cited in the Office Action for rejecting the claims under 35 U.S.C. § 103, does not disclose a heart-specific promoter, or a heart-specific phenotype. As a consequence, the two references, even if combined, do not teach every element of the claimed invention, and as such, no *prima facie* case of obviousness has been established. Applicants therefore respectfully submit that the rejections are improper and should be withdrawn.

Applicants further submit that the rejection of Claim 12 over Paigen et al. has been overcome by its amendment, clarifying that only a transgenic descendant is claimed.

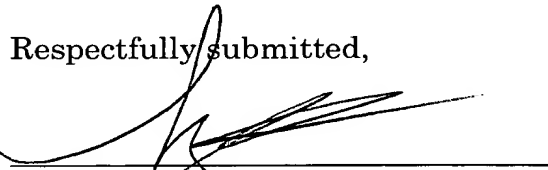
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Applicants have incorporated the elements recited in claim 26 into amended claim 1 which applicants respectfully submit is free of the prior art and is allowable. Because all other claims depend from claim 1, applicants respectfully submit that they are all in condition for allowance and earnestly solicit an early indication to that effect from the Examiner.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (CAM #: 029065.48487US).

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Respectfully submitted,



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